

## REMARKS

### ***Claim Rejections – 35 U.S.C. § 112***

Claims 1-20 were rejected as indefinite. In setting forth the rejection, the Examiner made specific reference to claims 1 and 2.

Regarding claim 1, the Examiner asserted that the claim failed to provide any structural relationship between the elements. Applicants respectfully dispute this rejection. Claim 1 is reproduced below with the structural relationship wording italicized.

1. A light generating module comprising:
  - a semiconductor light-emitting device;
  - a monitoring light-receiving element provided so as to be *optically coupled* to said semiconductor light-emitting device;
  - a driving element for driving said semiconductor light-emitting device; and
  - a housing having first, second, and third regions *arranged sequentially* in a direction of a predetermined axis, said housing *containing* said semiconductor light-emitting device, said driving element and said monitoring light-receiving element therein;wherein said semiconductor light-emitting device is *located in* said first region, said driving element is *located in* said second region, and said monitoring light-receiving element is *located in* said third region.

Applicants respectfully submit that claim 1 provides more than adequate structural relationship to one of ordinary skill in the art. The claim explains that the semiconductor is optically coupled to the light receiving element. It further explains how the housing is divided into three regions and how the light-emitting device, driving element, and monitoring light-receiving element are situated in those three regions.

Applicants have also reproduced claim 2 for the Examiner's consideration.

2. The light generating module according to claim 1, further comprising:
  - a first mounting member having first, second, and third regions arranged sequentially in a direction of a predetermined

axis; and

a second mounting member, located in said third region of said first mounting member, having a support surface;

wherein said monitoring light-receiving element is provided on said support surface;

wherein said monitoring light-receiving element has a light-detecting region for detecting light;

wherein said driving element is provided on said second region of said first mounting member;

wherein said semiconductor light-emitting device is provided on said first region of said first mounting member;

wherein said semiconductor light-emitting device has a pair of end surfaces and an active layer, said active layer extending from one of said pair of end surfaces to the other thereof;

wherein a region provided by said housing is divided into first and second sections by a plane extending along said active layer;

wherein said monitoring light-receiving element has a light-detection region provided in said first section; and

wherein said driving element is provided in said second section.

Claim 2 is not confusing, vague, or indefinite. The claim clearly recites arrangement of the first, second, and third regions of the first mounting member. The claim further recites that the monitoring light receiving element is provided on the support surface, which is located in the third region of the first mounting member.

The claims clearly comply with the requirements of 35 U.S.C. § 112. The undersigned respectfully remind that the test for definiteness under 35 U.S.C. § 112, second paragraph is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

Contrary to the assertions in the Office Action, the rejected claims adequately describe the invention to one skilled in the art. The present claims provide clear warning to others as to what would constitute infringement of the patent (when issued).

Although the Examiner may prefer the use of different terminology, this is not an adequate reason to reject the claims as indefinite. In reviewing the claim for compliance with the

second paragraph of 35 U.S.C. § 112, the Examiner should grant some latitude in the manner of expression even though the Examiner might prefer somewhat different claim language. Mere preferences can not be grounds for a rejection when other modes of expression selected by Applicants satisfy the statutory requirement. Reference is made to M.P.E.P. 2173.02.

In view of the foregoing, Applicants respectfully request that the rejection be withdrawn because the claims comply with the requirements of 35 U.S.C. § 112.

***Claim Rejections – 35 U.S.C. § 102***

Claims 1-5 and 8-14 are rejected as being anticipated under 102(a) by Kato (US 6,488,419), JP 2000-080694, or JP 2000-273514.

Applicants respectfully submit that the above referenced documents are not valid 102(a) prior art.

The present application was filed on February 22, 2002 and claims a priority date of **February 23, 2001**. The Examiner has indicated that he has received certified copies of the priority documents.

Kato was filed March 21, 2001, published as an application on February 14, 2002, and issued as a patent on December 3, 2002. Kato therefore is not proper 102(a) prior art against this application because the present application has a priority date of February 23, 2001.

JP 2000-080694 was filed on March 22, 2000, but was not published because it was considered withdrawn under Japanese patent law. Therefore, this document would not qualify as 102 (a) prior art against this application.

JP 2000-273514 was filed on September 8, 2000 and was first published on December 7, 2001 as publication number 2001-339118. This publication likewise would not be considered proper 102(a) prior art against this application.

Applicants also submit that the cited documents would not qualify as prior art against this

case under any of the other provisions of 35 U.S.C. § 102. As such, Applicants respectfully request that the 102 rejections be withdrawn.

***Claim Rejections – 35 U.S.C. § 103***

Claims 6 and 7 are rejected as obvious in light of Kato (US 6,488,419), JP 2000-080694, or JP 2000-273514 in further view of Hauer (US 6,456,641).

Claims 15-20 are rejected as obvious in light of Kato (US 6,488,419), JP 2000-080694, or JP 2000-273514 in further view of Ichino (US 6,155,724).

Applicants respectfully request that these rejections be withdrawn because the alleged primary references (Kato, JP 2000-080694, and JP 2000-273514) are not prior art against this application.


**CONCLUSION**

Applicants earnestly await allowance of the application. If any additional fees are due in connection with the filing of this response, such as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to Deposit Account No. 02-4300. Any overpayment can be credited to Deposit Account No. 02-4300.

Respectfully submitted,

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